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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,765	02/20/2002	Kazuhiro Ishida	017446-0323	3462
22428 7590 07/13/2010 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				
EXAMINER				
ALVAREZ, RAQUEL				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
07/13/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/077,765

Applicant(s)

ISHIDA, KAZUHIRO

Examiner

Raquel Alvarez

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34, 36, 37, 39-41, 43, 44, 46-48, 50, 51, 53-56 is/are pending in the application.
- 4a) Of the above claim(s) 55 and 56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34, 36, 37, 39-41, 43, 44, 46-48, 50, 51, 53 and 54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to communication filed on 4/27/2010.
2. Claims 1-33, 35, 38, 42 and 45 have been canceled. Claims 55-56 have been withdrawn.
3. Claims 34, 36-37, 39-41, 43-44, 46-48, 50-51 and 53-54 are presented for examination.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 34, 36-37, 39-41, 46-48, 50-51 and 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura (5,987,424 hereinafter Nakamura) in view of Kenney (5,515,424 hereinafter Kenney).

With respect to claims 34,36-37, 39-41, 43-44, 46-48, 50-51, 53-54 Nakamura teaches a communication terminal (i.e. subscriber telephone set 1); a registration request issuing means for issuing a registration request for advertisement information broadcast from an advertisement information broadcast server and receiving means for receiving advertisement information which is broadcast from said advertisement information broadcast server, based on said registration request (i.e. the telephone set

under contract to receive messages)(steps 1301 and 1302); and a display means for displaying said advertisement information received by said receiving means (Figure 14).

With respect to said display means for automatically displaying said advertisement information on a standby screen when the communication terminal is in standby state. Kenney teaches "the monitor 18 would **display informational screens for a period of 8-10 seconds each when the phone is not in use**. These still images are stored in a memory module 38, which could be a disk drive, in the phone. In some cases, the data could be downloaded from a central administration point" (col. 4, lines 27-32). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included automatically receiving advertisement information on a standby screen because such a modification would without any human interaction attract passerby to the telephone terminals.

With respect to the communication terminal being portable. Official Notice is taken that it is old and well known for devices or the like to be portable in order to provide portability. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the communication terminal being portable in order to obtain the above mentioned advantage.

Nakamura further teaches a registration cancellation means for requesting to stop broadcasting said advertisement information from said advertisement broadcast server (i.e. detecting subscriber termination/rejection of advertisements)(step 1303) and a registration cancellation means for requesting to stop broadcasting said advertisement information from said advertisement information broadcast server (i.e. exchange 4

determining if a cancellation request was received from the subscriber telephone set 1)((col. 24, lines 29-33).

Response to Arguments

6. Applicant states that Nakamura suggests that the subscriber telephone set 1 may perform a dialing operation for temporarily stopping the advertisement broadcast service that is on monthly contact basis but according to Applicant any combination of Nakamura with Kenney can bring about more than that the advertisement broadcast service provided under a monthly contract on the standby screen of the subscriber telephone set is stopped temporarily within the valid period of the contract. The Examiner wants to point out that Nakamura teaches the subscribing telephone set 1 subscribing to a service contract of when to begin and end/determining/canceling the broadcasting of the advertisements to telephone set 1. This service as oppose to Applicant's arguments is provided to the user when the user needs the services because the subscriber subscribes to the month, that he wants the advertisements to be provided to the telephone set 1. For instance, the user subscribe to a particular month of the subscription. Kenney teaches providing the information on a standby mode when the phone is not in use. The teachings of Nakamura and Kenney teaches, the terminal user receiving advertisements as per registration request example, the month of February and Kenney displaying the advertisements during standby state. Nakamura teaches displaying the advertisements during the month of February (Nakamura

anytime during the month of February and Kenney teaches displaying the phone when on standby mode/state (Kenney) during the contracted month of February. The combination of Nakamura and Kenney teaches registering the telephone set 1 during a particular month, Year. Etc as taught by Nakamura and providing/transmitting the advertisements during standby state during the contracted month in order to attract passerby to watch or listen to the advertisements during the standby state during the contracted month in order to better attract listeners and viewers to the advertisements.

7. In response to applicant's argument that in the present invention, the terminal user is allowed to receive the broadcast service only for a time interval desired by the user to thereby enjoy a reduction in wasteful expenditure of communication charges under contract, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

8. In addition, the advertisements are stopped in Nakamura when requested by the user terminal. The claims do not call for the advertisements being stopped on a permanent basis. The claims only call for stopping of the broadcast by said registration cancellation means. The claims do not call for the cancellation being permanent or not. Even if cancellation being on permanent were to be claimed, it is old and well known for subscriber to cancel subscription of a product or service and it would have been obvious to have combined the references of record to allow the subscriber to cancel the registration request when the advertisements are no longer needed.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Point of contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on (571)272-6782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/
Primary Examiner, Art Unit 3688

Raquel Alvarez
Primary Examiner
Art Unit 3688

R.A.
7/9/2010